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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,177

10/16/2003

Naomi L. Nakao

G30-016

7585

7590

10/18/2006

R. Neil Sudol
714 Colorado Avenue
Bridgeport, CT 06605-1601

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,177

Applicant(s)

NAKAO, NAOMI L.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on February 13, 2006, amended claims 1, 15, 22, 24-25 and 29 and new claims 44 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12-16, 20-21, 23-25, 33 and 37-41 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,585,642 to Christopher.

In regards to claim 1, Christopher discloses a flexible tube endoscope comprising a flexible elongate insertion shaft 30, said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 35 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface said slot having a second transverse dimension or width, said second transverse dimension or width being smaller than said first transverse dimension or diameter (see Figs. 1 and 4).

In regards to claims 2-4, 13-14, 23, 25 and 37-38, Christopher discloses a flexible tube endoscope, further comprising a closure member 77 removably connected

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to said insertion shaft to close said slot and wherein said closure member is an endoscope sheath circumferentially surrounding said insertion shaft (see Col. 7, Lines 18-24).

In regards to claims 5, 12 and 33, Christopher discloses a flexible tube endoscope, further comprising a catheter 40 removably disposed in said channel (see Figs. 1 and 4).

In regards to claims 15 and 39, Christopher discloses a flexible tube endoscope, wherein the catheter is held in the channel in a snap lock fit (see Fig. 4).

In regards to claims 16 and 40, Christopher discloses a flexible tube endoscope, wherein the catheter is provided at a proximal end with connectors for coupling the catheter to a source of irrigation fluid and a source of suction (see Fig. 3 and Col. 5, Lines 1-35).

In regards to claims 20 and 41, Christopher discloses a flexible tube endoscope, wherein the channel extends from a proximal end portion of the insertion shaft to a distal tip thereof (see Fig. 1).

In regards to claims 21 and 24, Christopher discloses a flexible tube endoscope, wherein the channel has a mostly circular cross-section divided by the slot, the channel being defined by a surface of the insertion member having a C-shaped cross-section (see Fig. 4).

Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,938,586 to Wilk et al.

In regards to claim 44, Wilk et al. disclose an endoscope accessory comprising: a sheath disposed around an endoscope insertion member and connectable thereto in the absence of an end cap attachable to a distal end of the endoscope insertion member; and a tubular channel member disposed along and connected to all inner surface of the sheath (see Col. 6, Lines 21-26 and Fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-9, 17-19, 29, 32 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,585,642 to Christopher in view of U.S. Patent No. 5,257,617 to Takahashi.

In regards to claims 6, 8-9, 17-19, 29, 32 and 34-36 Christopher discloses a flexible tube endoscope comprising a flexible elongate insertion shaft 30, said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 35 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface said slot having a second transverse dimension or width, said second transverse dimension or width being smaller than said first transverse dimension or diameter (see Figs. 1 and 4) but is silent with respect to wherein the catheter is fastened to the sheath. Takahashi teaches of an analogous endoscopic apparatus having a sheath 20 and a channel tube 30, wherein

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the channel tube 30 is rigidly secured to the distal end cover 22 (see Col. 3, Lines 30-65). Furthermore, Takahashi provides grooves wherein the insertion shaft is inserted into the grooves to removably attach the sheath to the insertion shaft (see Figs. 1-3a). It would have been obvious to one skilled in the art at the time the invention was made to fastener the catheter to the sheath in the device of Christopher to provide a more secure fitting between the sheath and the catheter as taught by Takahashi.

Claims 7 and ~~16~~ 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,585,642 to Christopher in view of U.S. Patent No. 4,866,049 to Darras.

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10/16/02

In regards to claims 7 and 26-28, Christopher discloses a flexible tube endoscope comprising a flexible elongate insertion shaft 30, said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 35 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface said slot having a second transverse dimension or width, said second transverse dimension or width being smaller than said first transverse dimension or diameter (see Figs. 1 and 4) but is silent with respect to wherein the sheath is provided with an adhesive. Darras teaches of an analogous endoscopic apparatus wherein an adhesive is applied to the interior surface 18 in the area of end 16. The adhesive would have sufficient adhesive power to hold the cover in place during use (see Col. 4, Lines 1-14). It would have been obvious to one skilled in the art at the time the invention was made to fastener provide an adhesive closure in

the device of Christopher to provide an alternate means for securely closing the sheath as taught by Darras.

Claims 10-11 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,585,642 to Christopher in view of U.S. Patent No. 5,817,015 to Adair.

In regard to claims 10-11 and 30-31, Christopher discloses a flexible tube endoscope comprising a flexible elongate insertion shaft 30, said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 35 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface said slot having a second transverse dimension or width, said second transverse dimension or width being smaller than said first transverse dimension or diameter (see Figs. 1 and 4) but is silent with respect to an entrainment member. Adair teaches an endoscope 200 having a sheath 202 with a pull tab 218 for assisting in placing the sheath 202 over the endoscope (see col. 7, lines 34-60). Adair thus demonstrates that providing a sheath with a pull tab for assisting in its placement and removal is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the sheath of Christopher with the pull tab 218 disclosed by Adair, as a means to assist in the placement and removal of the sheath 202.

Claims 22 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,585,642 to Christopher.

In regard to claims 22 and 43, Christopher discloses a flexible tube endoscope comprising a flexible elongate insertion shaft 30, said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 35 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface said slot having a second transverse dimension or width, said second transverse dimension or width being smaller than said first transverse dimension or diameter (see Figs. 1 and 4) but is silent with respect to wherein the channel is one of a plurality of channels formed along the outer surface of the insertion shaft. It would have been obvious to one skilled in the art at the time the invention was made to include a plurality of channels, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

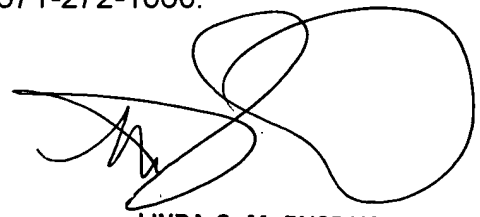
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *ml*

10/13/06



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